

ATTORNEY'S DOCKET
017220.0115

PATENT APPLICATION
08/425,766

#27
4/12/02
Dm

1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Greene et al.
Serial No. 08/425,766
Filing Date: April 19, 1995
Examiner: Norman, M.
Group: 3744
Title: METHOD AND APPARATUS FOR DISPOSING OF
WASTE MATERIAL

RECEIVED
APR 11 PM 3:20
MAIL ROOM
U.S. PATENT & TRADEMARK OFFICE

Assistant Commissioner
for Patents
BOARD OF APPEALS AND INTERFERENCES
Washington, D.C. 20231

Dear Sir:

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" under 37 C.F.R. § 1.10 on the date indicated below and is addressed to:

Assistant Commissioner for Patents
BOARD OF APPEALS AND
INTERFERENCES
Washington, D.C. 20231.

Willie Tiles
Name

April 9, 2002
Date of Signature

Express Mail No. EL 953636796 US

SUPPLEMENTAL APPEAL BRIEF

This Supplemental Appeal Brief is filed in compliance with the Order dated February 28, 2002, wherein the Board of Patent Appeals and Interferences required the Appellants to file a Supplemental Appeal Brief to address the impact the decision of *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001) ("*Pannu*") has on this appeal of the Examiner's rejection, under the recapture doctrine, of Claims 1-20. In *Pannu*, as particularly

noted in the February 28, 2002 Order, the Federal Circuit recited the following sentence: "On reissue, [the appellant] Pannu is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections." 258 F.3d at 1372.

RESPONSE

Neither the cited sentence of *Pannu* nor other portions of *Pannu* have any impact on the present appeal for at least the reason that the liquid filter element was initially in the independent claims (through error) and was not added via any amendment and Appellants are not trying to recapture any subject matter that was subsequently added to overcome prior art rejections. Therefore, Appellants are not in any way, in the words of *Pannu*, "attempting to recapture" any "precise limitation . . . added to overcome prior art rejections." *Pannu*, 258 F.3d at 1372.

During prosecution of the intraocular lens patent that was the subject of the challenged reissue in *Pannu*, the patentee (Pannu) amended the claims to add a specific limitation relating to the structure and shape of the "haptic" elements of the lens; specifically, the elements defined a "continuous substantially circular arc having a diameter greater than [the] lens body." *Id.* at 1378. "As originally filed, none of the claims in the [original] application limited the shape of the haptics." *Id.* at 1371. The limitation was added to overcome at least two prior art references, and Pannu specifically argued to the examiner during prosecution that "no such particular shape [as added to the claims in the amendment] is disclosed by" the prior art. *Id.* The Federal Circuit held that the removal of the limitation during the reissue proceeding was improper since, under the recapture doctrine enunciated in cases such as *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) and *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), the matter was surrendered during prosecution.

There is no indication that the court in *Pannu*, in making the statement that, "[o]n reissue, [the appellant] Pannu is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections," was attempting to define any new contours of the law regarding the circumstances under which subject matter will be deemed to have been surrendered during

prosecution. The statement does not appear in the section of the *Pannu* opinion dealing with, in the first instance, *whether* the subject matter of *Pannu* was surrendered during prosecution. Instead, the sentence appears at the end of a later paragraph considering Pannu's argument "that because the reissued claims were materially narrowed in other respects," the recapture rule should be avoided. *Pannu*, 258 F.3d at 1371-72. In rejecting this argument, the *Pannu* court relied upon the rule enunciated in *Anderson v. Int'l Eng'g & Mfg., Inc.*, 160 F.3d 1345, 48 USPQ2d 1631 (Fed. Cir. 1998) ("*Anderson*"), wherein the Federal Circuit held that "if the patentee is seeking to recover subject matter *that had been surrendered* during the initial prosecution this flexibility of analysis [i.e., the 'narrowed in other respects' argument] is eliminated, for the prosecution history establishes the substantiality of the change and estops its recapture." 160 F.3d at 1349 (emphasis added.) *Having already decided earlier in the opinion* that the shape of the haptics was surrendered by Pannu during prosecution, the *Pannu* court simply and tersely stated the logical result reached if applying the *Anderson* rule to Pannu's "narrowed in other respects" argument (i.e., that since the "precise" limitation (as opposed to the other, narrowing limitation that did not have to do with the shape of the haptics)) was surrendered during prosecution, "Pannu is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections." 258 F.3d at 1372.

Therefore, *Pannu* is easily distinguishable from the present appeal. The limitation sought to be removed during this reissue action was, unlike the haptic shape limitation in *Pannu*, in the original independent claims and was not subsequently added to overcome prior art rejections. There is nothing either expressly stated or implied in *Pannu* that changes the scope of the doctrine of recapture as enunciated by *Hester Industries* or any other cases cited in Appellants' Appeal Brief. In sum, *Pannu* necessitates no deviation from or revision to the arguments presented by Appellants in Appellants' Appeal Brief.


CONCLUSION

Pursuant to the February 28, 2002 Order of the Board of Patent Appeals and Interferences, Appellants respectfully respond that *Pannu* does not run counter to any aspect of Appellant's position for at least the reason that, in contrast to the patentee in *Pannu*, the liquid filter element was initially in the independent claims (through error) and Appellants are not trying to recapture any subject matter that was subsequently added to overcome prior art rejections.

Although Appellants believe that no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Appellants


Robert M. Chiaviello, Jr.
Reg. No. 32,461

CORRESPONDENCE ADDRESS:

Robert M. Chiaviello, Jr.
Baker Botts L.L.P.
2001 Ross Avenue, Suite 600
Dallas, Texas 75201-2980
(214) 953-6677

Date: April 9, 2002